

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Janik)	Examiner:	Chang, Eric
)		
Serial No.:	09/613,322)	Art Unit:	2116
)		
Filed:	July 11, 2000)	Attny Doc.:	81230.521US
)		
Title:	Clock With Link To The)		
	Internet)		

APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby submits this Appeal Brief, as required by the Decision On Petition mailed November 29, 2007, to appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 48-67.

The Commissioner is hereby authorized to charge any fee deficiency or credit overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

I. Real Party In Interest

The real party in interest is Universal Electronics Inc.

II. Related Appeals And Interferences

The Appellant is not aware of any pending appeals, interferences, or judicial proceedings which may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status Of The Claims

In the application claims 48-67 remain pending.

Claims 1-47 have been canceled without prejudice.

The Section VIII appendix provides a clean, double spaced copy of pending claims 48-67.

IV. Status Of Amendments

The claims are in condition for appeal -- no amendments to the claims are pending.

V. Summary Of The Claimed Subject Matter

In accordance with 37 CFR § 41.37(c)(1)(v), the following provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal with reference, by way of example only, to the specification by page and line number and to the drawings by reference characters:

Independent claim 48 is generally directed to a method of presenting content retrieved via the Internet and includes:

providing a content preference selection to a server 102 for use in connection with a search engine which functions to retrieve from the Internet 110 content that is relevant to the

content preference selection (Page 11, line 25-page 12, line 18; Page 14, lines 28-32; and Figs. 6 and 8);

receiving from the server at an alarm clock 10 via the Internet 110 the content that is relevant to the content preference selection as retrieved by the search engine (Page 11, line 25-page 12, line 18; Page 14, lines 28-32; and Figs. 6 and 8); and

causing the alarm clock 10 to present the content that is relevant to the content preference selection as retrieved by the search engine at a time that is programmed into the alarm clock 10 (Page 11, line 25-page 12, line 18; Page 14, lines 28-32; and Figs. 6 and 8).

Independent claim 58 is generally directed to a method of presenting content retrieved via the Internet and includes:

providing plural content preference selections to a server 102 for use in connection with a search engine which functions to retrieve from the Internet 110 plural content that is relevant to the plural content preference selections (Page 11, line 25-page 12, line 18; Page 14, lines 28-32; and Figs. 6 and 8);

receiving from the server at an alarm clock 10 via the Internet 110 the plural content that is relevant to the plural content preference selections as retrieved by the search engine (Page 11, line 25-page 12, line 18; Page 14, lines 28-32; and Figs. 6 and 8); and

causing the alarm clock 10 to present the plural content that is relevant to the plural content preference selections as retrieved by the search engine at a time that is programmed into the alarm clock 10, whereby the plural content is presented in a pre-programmed order (Page 11, line 25-page 12, line 18; Page 14, lines 28-32; and Figs. 6 and 8).

VI. Grounds Of Rejection To Be Reviewed On Appeal

In the Office Action of November 27, 2006 claims 48, 52-55, 57, 58, 62-65, and 67 were

rejected under 35 U.S.C. § 103 as being rendered obvious by Herold (U.S. Patent No. 5,832,067) as modified by Peterson (U.S. Patent No. 6,594,682) and claims 49-51, 56, 59-61, and 66 were rejected under 35 U.S.C. § 103 as being rendered obvious by Herold as modified by Peterson as further modified by Brown (U.S. Patent No. 6,587,822).

The Appellant requests review of the rejection of claims 48, 52-55, 57, 58, 62-65, and 67 under 35 U.S.C. § 103 based upon the combination of Herold and Peterson.

VII. Argument

A) Summary Of The Rejection Of The Claims

In rejecting the claims it was asserted that Herold teaches all of the limitations of the claims but acknowledged that Herold does not specifically teach that a port couples the alarm clock to the Internet to download information from a Web site or using content preferences at a search engine to retrieve information for downloading. It was, however, asserted that, because Herold does teach a device capable of connecting to a computer, it would have been obvious that a Web site server would be able to provide the requested information “substantially as claimed.” As concerns the use of a search engine, the rejection of the claims asserted that Peterson teaches an agent program that retrieves from the Internet at scheduled times information for display to a user (citing to the Abstract) and providing a content preference selection to a server (citing to col. 4, lines 58-67 and col. 5, lines 1-5) which functions to retrieve from the Internet content that is relevant to the content preference selection (citing to col. 5, lines 6-18). Based on this alleged disclosure within Peterson, it was concluded that it would have been obvious to modify Herold to employ an Internet search as taught by Peterson “so that a user’s desired content can be located on the Internet and thusly retrieved” and because the internet search means taught by Peterson

would “[allow] for additional client-side filtering of the retrieved Internet content.”

B) Applicable Law

It is well settled that, to establish a *prima facie* case of obviousness, two basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, the prior art reference (or references when combined) must teach or suggest all of the elements claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007).

C) Argument Concerning The Rejection of Claims 48, 52-55, 57, 58, 62-65, and 67
Claims 48, 52-55, 57, 58, 62-65, and 67 (and the claims which depend therefrom) presently stand rejected under 35 U.S.C. § 103 as allegedly being rendered obvious by Herold (U.S. Patent No. 5,832,067) as modified by the teachings of Peterson (U.S. Patent No. 6,594,682).

In the Office Action of November 27, 2006 and, more particularly, in the Advisory Action of April 3, 2007, it was asserted that the rejection of the claims was to be maintained because the combination of Herold and Peterson teaches the invention “substantially as claimed.” It is respectfully submitted that this assertion evidences that the combination of Herold and Peterson fails to present a *prima facie* case of obviousness which requires a combination of references to disclose, teach, and suggest the invention exactly as claimed, i.e., each and every element considering each and every word. For at least this reason it is respectfully submitted that the rejection of the claims must be withdrawn.

The invention claimed is directed to a method of presenting content retrieved via the Internet and includes providing a content preference selection to a server for use in connection

with a search engine which functions to retrieve from the Internet content that is relevant to the content preference selection; receiving from the server at an alarm clock via the Internet the content that is relevant to the content preference selection as retrieved by the search engine; and causing the alarm clock to present the content that is relevant to the content preference selection as retrieved by the search engine at a time that is programmed into the alarm clock.

It is respectfully submitted that neither Herold nor Peterson discloses, teaches, or suggests at least the claimed elements of providing a content preference selection to a server for use in connection with a search engine which functions to retrieve from the Internet content that is relevant to the provided content preference selection for return to the alarm clock as is claimed. It is for this reason that the combination of Herold and Peterson cannot be said to support a *prima facie* case of obviousness.

Considering first Herold, Herold discloses a method and an apparatus for transferring information from a remote server to an alarm clock. Specifically, the alarm clock has a selectable switch indicative of a plurality of states and the remote server stores a plurality of messages. At a designated time, the alarm clock generates an alarm signal which is used to dial the remote server and the remote server selects a message to return to the alarm clock, the message being selected based upon the state of the selectable switch. Accordingly, it will be appreciated that the system of Herold, which retrieves information from a source of information that is located at an address that is known to the system even before the user indicates any preference for content, i.e., by moving the selectable switch, does not function by providing a content preference selection to a server for use in connection with a search engine which functions to retrieve from the Internet content that is relevant to the provided content preference

selection for return to the alarm clock as is claimed. That Herold fails to disclose at least these claimed elements has been acknowledged in the rejection of the claims.

Considering now Peterson, it is respectfully submitted that Peterson similarly fails to disclose, teach, or suggest providing a content preference selection to a server for use in connection with a search engine which functions to retrieve from the Internet content that is relevant to the provided content preference selection for return to another device, such as an alarm clock, as is claimed. Rather, Peterson discloses a system in which a device is provided with an index to Web content where the index (as opposed to a search engine) provides a way to locate actual Web content, such as by specifying a URL or a channel for each piece of Web content that is listed in the index. (Col. 4, lines 21-29 *cited to in the Advisory Action of April 3, 2007*; Col. 6, lines 17-26). More particularly, within the system of Peterson, the device is responsible for retrieving Web content by using an address that has been pre-designated within the index (Col. 9, lines 36-41) and, prior to or after the Web content is retrieved from each address that has been pre-designated within the index, the device may use user preferences to organize and/or filter the Web content. (Col. 10, lines 34-50). Thus, *exactly like the system disclosed within Herold*, the system of Peterson is designed to retrieve information from a particular sources of information located at a pre-designated address which address is known to the system before the user ever provides any form of “filtering” preferences. As will therefore be appreciated, the system disclosed within Peterson is in direct contrast to the claimed system which is not limited to obtaining information that is located at pre-designated addresses but instead has the distinct advantage of allowing the entirety of the Internet to be comparatively more timely searched to obtain information from a multitude of possible sources, located at addresses that need not be determined prior to the execution of the search, which may have

information that is relevant to a provided content preference selection for ultimate return to the playback device, i.e., the alarm clock.

While the rejection of the claims has asserted that Peterson discloses that a search engine is used to retrieve content at Col. 3, lines 20-31, it is respectfully noted that this disclosure is set forth within the background section of Peterson. Specifically, at Col. 3, lines 20-31, Peterson describes that it is known to generally use a search engine to find information on the Internet. However, when Peterson is fully and fairly considered in its entirety as is required, i.e., it is impermissible to pick and choose from a reference only that which will support a given position to the exclusion of what the reference teaches in its entirety, Peterson teaches directly against the use of a search engine in a system such as that which is claimed. In this regard, Peterson notes that it is disadvantageous to use search engines to retrieve content since “computers have a hard time distinguishing between valuable information and worthless information, and are not very good at categorizing information.” (Col. 3, lines 37-40). For this reason, rather than utilize a search engine to locate information, Peterson describes a system that provides an index to allow for the retrieval of information from Web content sources that are located only at known, pre-designated addresses or URLs.

From the foregoing, it is respectfully submitted that the combination of Herold and Peterson cannot be said to disclose each and every element set forth in the claims as is required of a *prima facie* case of obviousness. Specifically, as discussed above, neither Herold nor Peterson discloses, teaches, or suggests the claimed element of providing a content preference selection to a server for use in connection with a search engine which functions to retrieve from the Internet content that is relevant to the provided content preference selection for presentation at a time that is programmed into a device such as an alarm clock. Furthermore, it is respectfully

noted that, as also discussed above, rather than suggest modifying Herold to arrive at the invention that is set forth within the claims as is additionally required of a *prima facie* case of obviousness, Peterson teaches directly against, i.e., criticizes, discredits, or otherwise discourages, modifying the system of Herold to further include a server that has an associated search engine which functions to retrieve from the Internet content that is relevant to a provided content preference selection. Yet further, while the combination of Herold and Peterson fails to present a *prima facie* case of obviousness, it is respectfully submitted that, were Herold modified according to the teachings of Peterson, the modified Herold system would not be the exact system that is claimed. In this regard, when Peterson is considered in its entirety as is required, rather than suggest modifying Herold to arrive at the exact system claimed Peterson suggests modifying the system of Herold to replace the pre-designated phone number from which information is retrieved with an index having pre-designated Web content addresses, such as URLs, from which information is retrieved. It is for each of these reasons that it is respectfully submitted that the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.


D) Conclusion

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: January 28, 2007

By:



Gary R. Jarosik; Reg. No. 35,906
Greenberg Traurig, LLP
77 W. Wacker Drive, Suite 2500
Chicago, Illinois 60601
(312) 456-8449

VIII. Claims Appendix

The following is a clean copy of the claims involved in the appeal:

48. A method of presenting content retrieved via the Internet, comprising:

providing a content preference selection to a server for use in connection with a search engine which functions to retrieve from the Internet content that is relevant to the content preference selection;

receiving from the server at an alarm clock via the Internet the content that is relevant to the content preference selection as retrieved by the search engine; and

causing the alarm clock to present the content that is relevant to the content preference selection as retrieved by the search engine at a time that is programmed into the alarm clock.

49. The method as recited in claim 48, wherein the content preference selection is provided by interacting with a server Web page.

50. The method as recited in claim 48, wherein the content that is relevant to the content preference selection as retrieved by the search engine is streamed to the alarm clock.

51. The method as recited in claim 50, wherein the content that is relevant to the content preference selection as retrieved by the search engine is converted from text to synthesized speech.

52. The method as recited in claim 48, wherein the content that is relevant to the content

preference selection as retrieved by the search engine is stored within a memory of the alarm clock prior to the time that is programmed into the alarm clock..

53. The method as recited in claim 52, wherein the content that is relevant to the content preference selection as retrieved by the search engine is received at the alarm clock at a user selected time.

54. The method as recited in claim 53, comprising causing the alarm clock to access the server at the user selected time to thereby receive the content that is relevant to the content preference selection as retrieved by the search engine.

55. The method as recited in claim 54, wherein the alarm clock accesses the server by automatically dialing a designated phone number.

56. The method as recited in claim 52, wherein the content that is relevant to the content preference selection as retrieved by the search engine is converted from text to synthesized speech.

57. The method as recited in claim 48, wherein the search engine functions to retrieve from the Internet the content that is relevant to the content preference selection on a daily basis.

58. A method of presenting content retrieved via the Internet, comprising:
providing plural content preference selections to a server for use in connection with a

search engine which functions to retrieve from the Internet plural content that is relevant to the plural content preference selections;

receiving from the server at an alarm clock via the Internet the plural content that is relevant to the plural content preference selections as retrieved by the search engine; and

causing the alarm clock to present the plural content that is relevant to the plural content preference selections as retrieved by the search engine at a time that is programmed into the alarm clock, whereby the plural content is presented in a pre-programmed order.

59. The method as recited in claim 58, wherein the plural content preference selections are provided by interacting with a server Web page.

60. The method as recited in claim 58, wherein the plural content that is relevant to the plural content preference selections as retrieved by the search engine is streamed to the alarm clock.

61. The method as recited in claim 60, wherein the plural content that is relevant to the plural content preference selections as retrieved by the search engine are converted from text to synthesized speech.

62. The method as recited in claim 58, wherein the plural content that is relevant to the plural content preference selections as retrieved by the search engine are stored within a memory of the alarm clock prior to the time that is programmed into the alarm clock..

63. The method as recited in claim 62, wherein the plural content that is relevant to the plural

content preference selections as retrieved by the search engine are received at the alarm clock at a user selected time.

64. The method as recited in claim 63, comprising causing the alarm clock to access the server at the user selected time to thereby receive the plural content that is relevant to the plural content preference selections as retrieved by the search engine.

65. The method as recited in claim 64, wherein the alarm clock accesses the server by automatically dialing a designated phone number.

66. The method as recited in claim 62, wherein the plural content that is relevant to the plural content preference selections as retrieved by the search engine are converted from text to synthesized speech.

67. The method as recited in claim 58, wherein the search engine functions to retrieve from the Internet the plural content that is relevant to the plural content preference selections on a daily basis.

IX. Evidence Appendix

No evidence is being submitted herewith.

X. Related Proceedings Appendix

No copies of decisions rendered by a court or the Board are being submitted herewith.

CHI 56,967,151v1